

### **REMARKS**

Applicant respectfully requests reconsideration of the application.

Claims 1-5, 11, 15-18, 20-21 and 24-25 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,243,481 by Tao. Claims 19 and 22-23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Tao in combination with U.S. Patent No. 6,148,091 to DiMaria. Claims 6-10 and 12-14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Tao in combination with DiMaria, and further in view of U.S. Patent No. 4,109,237 by Hill.

#### **Preliminary Issues**

The Office objected to Fig. 2 as not including reference label 202. A replacement figure 2 is attached with reference number 202 included.

The Office objected to Fig. 2 because reference number 310 was not mentioned in the specification. Applicant has amended the specification to include a reference to 310.

The Office objected to Fig. 3 because block labeled "user authenticated" did not have a reference number. A replacement figure 3 is attached with a reference number 422 assigned to this block. The specification has also been amended to refer to 422.

"RGG" at page 7, line 14 has been amended to "RGB" per paragraph 4 of the Action to correct the typographical error noted by the Office.

#### **Claim Rejections**

##### **Claim 1**

Claim 1, as amended, clarifies the phrase: "user attribute." Specifically, claim 1 recites: "wherein the user attribute comprises an image of an identifying characteristic of the user." The cited art fails to teach this aspect of claim 1 in combination with the other claim elements. Tao fails to disclose this aspect of claim 1 in combination with the other elements, and therefore, does not anticipate claim 1.

The Office contends that one of skill in the art would be motivated to combine the retinal scan of DiMaria in place of the voice data taught by Tao. The voice data that the Office cites in Tao at col. 6, lines 55-56 refers to a voice recognition system as an input means. Voice recognition systems are understood to convert a voice signal into text or some other form of input command interpreted by the system. Tao fails to suggest that this voice recognition input

is used to identify characteristics of the user as claimed. Tao describes that the embedded data can be alpha-numeric characters or audio signals, but not an image or data derived from an image. Tao provides no teaching that the audio signals may be signals identifying characteristics of the user as claimed.

Moreover, Tao and the other cited references do not provide the motivation to replace the voice recognition system cited in Tao, which operates on audio input, with a device for capturing an image identifying characteristics of the user as claimed. DiMaria refers to a retinal scan, but not in the context of media signal capture as claimed. DiMaria notes that a retina pattern may be encoded into a magnetic strip, but provides no description of how to capture it, and provides no motivation to capture a retina pattern in a media signal capture device that encodes the retina pattern into a media signal captured by the device as claimed. Hill refers to a device for capturing an image of person's eye, but there is no suggestion of how to use this image in a media capture device as claimed. Therefore, the cited art fails to disclose, teach or suggest the claimed combination.

#### **Claims 2-5**

Claims 2-5 are patentable for the same reasons as claim 1.

#### **Claim 6**

Claim 6 is re-written in independent form. No change in scope of this claim is intended by this amendment. The Office has not established that the combination of Tao, DiMaria and Hill teaches all of the claimed elements. For example, the references do not teach a camera with an eyepiece that is used to capture a retinal scan, which is then encoded in a media signal captured by the camera. In addition, the Office has not established that these references provide the necessary motivation to combine all of the elements of the claim. The Office's stated motivation is that "one of ordinary skill in the art would have been motivated to use the eyepiece to have the eye at a fix[ed] position in order to scan the retina precisely." This purported motivation is provided in hindsight and is not based on any motivation derived from the references themselves. In addition, even assuming this motivation comes from knowledge in the prior art, it does not relate to teaching one to modify the camera in Tao to include an eyepiece

used for capturing a retinal scan as claimed. In sum, the Office has failed to establish a prima facie case of obviousness for claim 6 as required in MPEP 2142 and 2143.

### **Claims 7-10**

Claims 7-10 are patentable for the same reasons as claim 6. In addition, they include additional elements not disclosed, taught or suggested in the cited art. The Office has not established a prima facie case of obviousness for these claims because it has merely incorporated arguments intended for other claims with different claim elements. Since these incorporated arguments pertain to claims with different elements, the Office has not shown how the cited art teaches each and every element of claims 7-10.

### **Claim 11**

Claim 11 has been amended in a similar manner as claim 1 and is patentable for the same reasons as claim 1.

### **Claim 12**

Claim 12 has been re-written in independent form. No change in claim scope is intended by this amendment. The Office contends that DiMaria discloses the user attribute capture unit that captures a retinal pattern. However, in the previous paragraph of the Action, the Office acknowledges that: "DiMaria suggests of using the retinal pattern scan but does not further disclose the details of retinal pattern scan." This latter statement by the Office conflicts with the Office's position on claim 12. As noted, DiMaria mentions a retinal pattern, but does not disclose an image sensor in a digital camera for use as a user attribute capture unit as claimed. As a result, the Office has not established a prima facie case of obviousness for claim 12.

### **Claim 13**

The Office contends that Tao teaches the claimed image sensor of claim 13. However, Tao fails to disclose that the image sensor 114 in Fig. 1B "is used to capture the user attribute" as well as the "subject image into which the user attribute is encoded. The Office further contends that DiMaria discloses the claimed subject image into which the user attribute is encoded.

However, DiMaria refers to a retina pattern encoded in a magnetic stripe. This magnetic stripe is not a subject image as claimed. Therefore, the Office has not established a prima facie case of obviousness for claim 13.

#### **Claim 14**

The Office relies on Tao at col. 5, lines 12-24 as allegedly teaching the elements of claim 14. However, this passage relates to a cursor control device of a computer system 190 shown in Fig. 1A. This computer system does not include a digital camera as claimed. Thus, the Office has failed to establish a prima facie case of obviousness for claim 14.

#### **Claims 15-16**

Claims 15 and 16 are patentable for the same reasons as claim 11.

#### **Claim 17**

Claim 17 recites that the user attribute capture unit includes an image sensor. Tao fails to disclose an image sensor for capturing the image of the identifying characteristic of the user as claimed. The cited art fails to teach the combination of elements in claim 17.

#### **Claim 18**

The cited art fails to teach that the user attribute comprises both an image and voice recording as claimed.

#### **Claim 19**

Claim 19 is patentable for the same reasons as claim 11, and includes additional elements that distinguish it from the cited art.

#### **Claim 20**

Claim 20, as amended, recites: "wherein the user attribute data comprises a representation derived from an image of an identifying characteristic of the user." The cited art fails to teach this aspect of claim 20 in combination with the elements of claim 20.

**Claims 21-25**

Claims 21-25 are patentable for the same reasons as claim 20 and include additional elements not taught in the cited art. For example, claim 23 recites a fingerprint scan. DiMaria refers to a fingerprint as the Office has noted, but DiMaria fails to provide any teaching of how this fingerprint is captured within a capture device that also captures the media signal into which the fingerprint is encoded.

**Concluding Remarks**

The cited art fails to disclose, teach or suggest all of the elements of the claims. Therefore, the claims should be in condition for allowance.

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